REMARKS

Claims 1, 3-5, 8, 11-13, and 16-25 are cancelled. Claims 2, 6, 7, 9, and 14-15 have been amended herein. New claim 26 has been added.

Election/Restriction

The Examiner has made final the Restriction Requirement as set forth on page 3 of the September 13, 2001 Office Action. The claims have been amended herein to be limited to the compounds of Group I. Rejoinder of claims 7, 10 and 14 is respectfully requested.

Issues under 35 U.S.C. §112, 1st paragraph

Claims 24-25 are rejected under 35 U.S.C. §112, 1st paragraph. Applicants note that in the Examiner's comments of the outstanding Office Action, the Examiner appears to confuse the test for the written description requirement with the test for enablement. The Examiner's comments on page 3 relate to the written description requirement, and the Examiner abruptly switches topics beginning in the first full paragraph on page 4 of the outstanding Office Action. Here the Examiner begins to talk about the enablement requirement. As such, the rejection is completely improper.

However, in the interest of expediting the allowance of the application, claims 24 and 25 have been cancelled.

Rejections under 35 U.S.C.§102(b)

Claims 1, 2, 6, 9 and 15 have been rejected under 35 U.S.C.§102(b) as being anticipated by Sammes et al., J.C.S. Perkin I, 1981, pp. 2835-2839. Specifically, the Examiner cites compounds "e" and "m" as described in the second column on page 2835. The Examiner also states that compounds "b", "c", "d", "j", "k", "l", "n" and "o" are obvious. Applicants traverse this rejection and withdrawal thereof is respectfully requested.

Sammes et al. describe the synthesis and mechanistic studies of 4-substituted pyridines. In Sammes et al., a 2-benzyl-2-pyridinyl diethyl malonate is described as an intermediate compound. However the 2-benzyl-2-pyridyl-methyl malonate of the present invention is not described in Sammes et al. In addition, the property of the compounds of the present invention as potassium channel modulating drugs is in no way disclosed or suggested in Sammes et al. As such, the present invention is neither disclosed nor suggested by Sammes et al. and withdrawal of the rejection is respectfully requested.

Claims 1, 2, 6 and 15 have been rejected under 35 U.S.C. §102(b) as being anticipated by Umemoto et al., J.A.C.S., 1990. The Examiner appears to be relying upon compounds 38, 39 and 40 as disclosed in Table VI on page 8568 of Umemoto et al. to support this rejection. Applicants traverse this rejection and withdrawal thereof is respectfully requested.

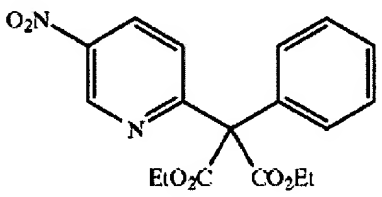
Umemoto et al., like Sammes et al., describe the synthesis and mechanistic studies of 4-substituted pyridines. In Umemoto et al. a 2-benzyl-2-pyridinyl diethyl malonate is also described as an intermediate compound. However the 2-benzyl-2-pyridyl-methyl malonate of the present invention is not described in Umemoto et al. In addition, the activity of the compounds of the present invention as potassium channel modulating drugs is in no way disclosed or suggested in Umemoto et al. As such, the present invention is neither disclosed nor suggested by Umemoto et al. and withdrawal of the rejection is respectfully requested.

Claims 1, 2, 6 and 9 have been rejected under 35 U.S.C. §102(b) as being anticipated by Mohrbacher et al., '540. The Examiner appears to be relying upon the compounds described at column 3, lines 26, 63-64 and 71 to support the rejection. Applicants traverse this rejection and withdrawal thereof is

respectfully requested. Mohrbacher et al. describe particular indolinzine derivatives having hypotensive and anti-inflammatory activities. The 2-pyridylmethyl diethyl malonate of Mohrbacher et al. is disclosed as being an intermediate compound. However, as with the references discussed above, Mohrbacher et al. fails to disclose the 2-phenyl-2-pyridyl-methyl malonate of the invention. As such, the present invention is not anticipated by the teachings of Mohrbacher et al. In addition, there is no disclosure in Mohrbacher et al. of the potassium channel modulating activity associated with the compounds of the present invention. Withdrawal of the rejection is therefore respectfully requested.

Claims 1, 2 and 6 are rejected under 35 U.S.C. §102(b) as being anticipated by Kaneko et al., WO '720. The Examiner is relying upon compound "149" of WO '720 which is an intermediate in the process of making the final product compounds.

Compound "149" has the following structure:

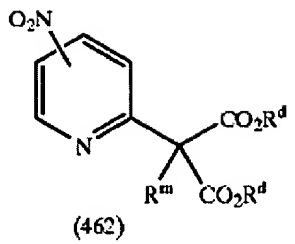


Diethyl 2-phenyl-2-(5-nitropyridin-2-yl)malonate. Applicants traverse this rejection and withdrawal thereof is respectfully requested.

Kaneko et al. disclose the synthesis and mechanistic studies of 4-substituted pyridines. Kaneko et al. specifically describes a 2-phenyl-2-pyridinyl diethyl malonate ester, which is an intermediate compound in the synthesis pathway of the compounds of interest in the reference. Kaneko et al. fails to disclose the 2-phenyl-2-pyridyl-methyl malonate of the invention. As such, Kaneko et al. fails to anticipate the present invention and withdrawal of the rejection is respectfully requested.

Rejections under 35 U.S.C.§103

Claims 1, 2 and 6 have been rejected under 35 U.S.C.§103 as being obvious over Kaneko '720. Further to the discussion of Kaneko '720 as noted above, the Examiner has also taken the position that it would be obvious to modify compound "149" to be any of the compounds shown in the following genus:



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wherein R^m represents hydrogen, optionally substituted alkyl optionally having a heteroatom and optionally having an optionally substituted aryl, heteroaryl or heterocycloalkyl ring, optionally substituted aryl, optionally substituted heteroaryl or optionally substituted heterocycloalkyl; and R^d represents lower alkyl. Applicants traverse this rejection and withdrawal thereof is respectfully requested.

As discussed above, Kaneko et al. fails to disclose the compounds of the invention. In addition, the compound of the reference that is relied on by the Examiner is an intermediate compound in the reference. Kaneko et al. fails to teach or suggest in any way the potassium ion channel modulating activity associated with the compounds of the present invention. As such, there would be no motivation for one skilled in the art to modify the compounds of Kaneko et al. to achieve the present invention. The present invention is therefore not obvious over Kaneko et al. and withdrawal of the rejection is respectfully requested.

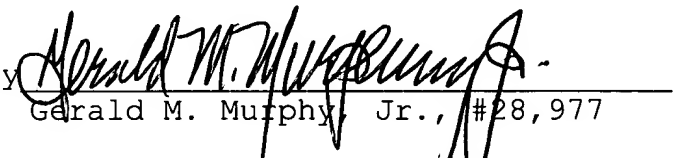
Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact MaryAnne Armstrong, PhD (Reg. No. 40,069) at the telephone number of the undersigned below.

Applicants request a one (1) month extension of time for filing the present response. The required fee is attached hereto.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By 

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